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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,418	07/26/2000	Eric C. Anderson	P206/1847P	8121

29141 7590 10/28/2003

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EXAMINER

SOLOMON, GARY L

ART UNIT	PAPER NUMBER
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2615

5

DATE MAILED: 10/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/626,418

Applicant(s)

ANDERSON ET AL.

Examiner

Gary L Solomon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the cross-reference to related and copending applications, the application serial numbers need to be inserted.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-9 and 12-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Safai (US 6,167,469).

For claims 1 and 12, Safai discloses a method and system for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device (Abstract and Column 3, Lines 47-67), the method and system comprising the steps of:

(a) storing an action list on the image capture device (Abstract), the action list including one or more items representing actions that the server should take with respect to uploaded images (Abstract)

(b) displaying the action list to the user on the image capture device after the user initiates an image upload process (Figure 4A)

(c) after the user selects at least one of the items in the action list, sending the

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images and the selected action list item from the image capture device to the server (Abstract); and

(d) performing the action on the uploaded images specified by the selected action item (Figure 5A and 5B).

For claims 2 and 13, Safai discloses all the previous limitations further including the step of providing the server as part of a photo-sharing service website (Column 15, Lines 27-59).

For claims 3 and 14, Safai discloses all the previous limitations further including the step of providing the action list with at least one of a print item, a store item that instructs the server where to store the images, a send item that instructs the server where to send the images (Figure 3).

For claims 4 and 15, Safai discloses all the previous limitations further including the step of providing that the store item (Figure 4F, Element 476) instructs the server to store the images within the photo-sharing service website Figure 4F, Element 466).

For claims 5 and 16, Safai discloses all the previous limitations further including the step of providing that the store item instructs the server to store the images to a location external (Figure 4E, Element 456) to the photo-sharing website (Figure 4F, Element 466).

For claims 6 and 17, Safai discloses all the previous limitations further including the step of providing an e-mail address as the send item in the action list (Figure 4F, Element 476; Column 9, Lines 14-25).

For claims 7 and 18, Safai discloses all the previous limitations further including the step of allowing the user to create the action list on the image capture device (Figure 4B).

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For claims 8 and 19, Safai discloses all the previous limitations further including the step of automatically downloading the action list from the server to the image capture device after the image capture device establishes a connection with the server (Figure 4F).

For claims 9 and 20, Safai discloses all the previous limitations further including the steps of creating a user account for the user the first time the image capture device establishes a connection with the server, and creating a default action list for the user (Column 15, Lines 16-27).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10-11 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Safai (US 6,167,469) in view of Steinberg (US 6,006,039).

For claims 10 and 21, Safai discloses all the previous limitations but lacks further including the step of allowing the user to manually create the action list on the photo-sharing service website by navigating to the photo-sharing service website using a web browser and manually creating the action list.

However Steinberg discloses a method of allowing the user to manually create the entering of "text and graphics" (Column 4, Line 56). It would have then been obvious to create the action list, which consists of "text and graphics."

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Creating an action list or sending information to be displayed on a camera from a computer through external means as an obvious variation of Steinberg would be obvious addition to Safai's system to one of ordinary skill in the art in order to allow the user of the digital camera to create his or her own action list that would tell the camera to perform actions external to the camera. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the teachings of Steinberg with the system of Safai in order allow the user to transfer his own action list to perform operations external to the camera such as printing or email.

For claims 11 and 22, Steinberg further discloses an obvious variation of the previous limitations further including the step of automatically creating the action list on the photo-sharing service website in response to the user actions performed on the photo sharing website though a web browser (Column 1, Lines 65 through Column 2, Lines 1-55; Column 4, Lines 32-56).

As previously stated in the rejections for claims 10 and 21, the entering of "text and graphics" through external means is taught by Steinberg. Automatically creating the action list on the photo-sharing service website in response to the user actions performed on the photo sharing website though a web browser is an obvious variation of Steinberg's method and encompasses entering text and graphics through an external means. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to configure the teachings of Steinberg with the system of Safai in order to automatically create an action list to perform operations external to the camera such as printing or email.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary L Solomon whose telephone number is (703)-305-4370.

The examiner can normally be reached on Monday - Friday 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christensen, B Andrew can be reached on (703)-308-9644.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for informal or draft communications, please label
"Proposed" or "Draft")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the customer service number **(703) 306-0377**.



October 20, 2003



**ANDREW CHRISTENSEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**